

Arguments

Entry of the following response, as well as reconsideration and withdrawal of the rejections of record, is respectfully requested.

Summary of Status of Amendment and Office Action

In the present amendment, no claim is cancelled, and claims 38, 42, 44, 46, 49-65, and 63-73 are amended. Therefore, claims 38-73 are pending in the application, with only claim 38 being independent.

In the Office Action dated March 9, 2006, claims 38-73 are rejected under 35 U.S.C. 102(e) as anticipated by US Patent No. 6,596,401 ("the '401 patent").

Additionally, claims 38-73 are rejected for obviousness-type double patenting over claims 1-20 of the '401 patent or over claims 1-48 of U.S. Patent No. 6,716,895 ("the '895 patent").

Further, claims 42, 44, 46 and 49-73 are rejected under 35 U.S.C. 112, second paragraph, as indefinite.

It is respectfully submitted that entry of this amendment after final rejection is proper because the amendment reduces the number of issues for appeal, clarifies issues relating to the composition and medical device claims, and is responsive to all rejections of record.

Telephone Interview

Applicant thanks the Examiner for the courtesy extended during an August 22, 2006 telephone call with the Applicant's representatives, Arnold Turk and Paul Braier.

During the interview, the Examiner indicated that the alternative-claiming language would be acceptable if written in the format "chosen from: a, b, or c," *i.e.*, by

replacing the "and" with an "or." The present Amendment amends the claims to conform with this suggestion.

Regarding the word "derivative," Applicant noted that the claim recitation clearly indicates that the recited derivative is a polymer. The Examiner requested that such arguments be put into writing, and those arguments are presented below.

Regarding the anticipation rejection, Applicant also explained that the allegedly anticipatory document does not anticipate at least because the term "colloid" (recited in the sole pending independent claim) has no support in the originally-filed application, but was only added in a CIP application dated after the present application. In this Amendment, Applicant has instead chosen to overcome this rejection by showing that the unclaimed subject matter of the reference is Applicant's own work.

Response to Rejection of Claims 38-73 as Anticipated by the '401 Patent

Claims 38-73 are rejected as anticipated under 35 U.S.C. 102(e) by the '401 patent. As stated in the attached Second Declaration of Richard N. Terry (the sole inventor of the present application), subject matter of the '401 patent that is cited in the Office Action, and that is disclosed but not claimed, includes subject matter that is the invention of the present inventor, and is a description of his own previous work. A disclosure of Applicant's own invention less than one year before the filing date cannot be utilized against the Applicant unless there is a bar under 102(b).

For at least the above reason, it is respectfully requested that the rejection of claims 38-73 as anticipated by the '401 patent be reconsidered and withdrawn.

Response to Rejections of Claims 38-73 for Obviousness-Type Double Patenting

Claims 38-73 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-20 of the '401 patent.

Claims 38-73 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-48 of the '895 patent.

In response to the double patenting rejections, Applicant submits herewith an executed Terminal Disclaimer pursuant to 37 C.F.R. 1.321(c). Applicant is filing the enclosed Terminal Disclaimer merely to remove any issue as to whether the claims of the above-identified application conflict in any way with those of either of U.S. Patents No. 6,596,401 or 6,716,895. Applicant emphasizes that the Terminal Disclaimer is being filed only to expedite the allowance of the pending claims, and does not express any agreement or acquiescence with the rejection of record. It is thus respectfully requested that the double-patenting rejection be withdrawn.

Response to Rejections Under 35 U.S.C. 112, Second Paragraph

Claims 42, 44, 46, 49-60, 66-70 and 73 are rejected as containing improper Markush language. In response, Applicant submits that the previous language is acceptable for alternative claiming, and is not Markush language. Nevertheless, in order to expedite issuance of a patent, the claims are herein amended to employ an equivalent alternative claiming language using "or," as discussed with the Examiner. Accordingly, it is respectfully requested that this rejection be withdrawn as moot.

With regard to this amendment, Applicant notes that these claims utilize open language, and therefore include any one or combination of the recited variations, and are also open to the inclusion of other ingredients.

Claims 66-73 are rejected as depending from a canceled base claim. In response, these claims have been amended to depend from pending claim 38 rather than from canceled claim 1. Accordingly, it is respectfully requested that this rejection be withdrawn as moot.

Claims 61-65 are rejected as depending from claim 38, which is not an article claim. In response, claim 61 is amended to depend from claim 38, and claims 64 and 65 are amended to depend from claim 61. As claim 62 depends from amended claim 61, and claim 63 from 62, it was not necessary to amend these claims. Accordingly, it is respectfully requested that this rejection be withdrawn as moot.

Claim 44 is rejected as rendered indefinite by use of the word "derivatives." The rejection asserts that carbon dioxide is a derivative of the recited polymers, derived by burning. In response, it is respectfully noted that the claim language clearly limits the "derivatives" to polymers. That is, the claim (as amended) recites "wherein the polymer is chosen from: [a list of polymers], or mixtures, derivatives, or copolymers thereof." Thus, the word "derivatives" refers to polymer derivatives, and would not include non-polymer derivatives such as the carbon dioxide referred to in the rejection.

Moreover, it is respectfully submitted that this term is definite because a person of ordinary skill in the art, using the specification as a guide, would understand what polymer derivatives are included in this recitation. A lengthy description of polymers (and monomers thereof) is present in the application at, *inter alia*, page 28, line 8 through page 31, line 27. The description of polymers and monomers therein includes polymers generally recited in claim 44, as well as derivatives. Some polymer derivatives are discussed, for example, at page 29, lines 17-23, which discloses a broad

category of polymers and functional groups thereon. Additional polymer derivatives are described at page 31, lines 17-27. Other portions of the specification describe yet additional polymer derivatives. Moreover, the person of ordinary skill in the art, using the specification as a guide (*e.g.*, page 27, lines 5-25, page 28, lines 28-31), would understand the scope of the claims. Thus, it is respectfully requested that this ground of rejection be reconsidered and withdrawn.

If the Examiner has suggestions for alternative language for the term "derivatives," he is respectfully requested to contact the undersigned to discuss this term.

None of the claim amendments were made to overcome a rejection based upon prior art. Thus, the claim amendments should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

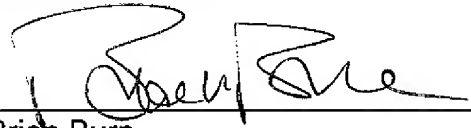
CONCLUSION

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections and objections of record, and allow each of the pending claims.

Applicants therefore respectfully request that an early indication of allowance of the application be indicated by the mailing of the Notices of Allowance and Allowability.

Should there be any questions, the Examiner is invited to contact the undersigned at 678-342-4880.

Respectfully Submitted,
Richard N. TERRY

A handwritten signature in black ink, appearing to read 'Brian Burn', is written over a horizontal line.

Brian Burn
Reg. No. 44,455

Date: 22 Sept. 2006